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LOUTE, OSCAR A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,682

Applicant(s)

HAPARNAS, ZIV

Examiner

OSCAR A. LOUIE

Art Unit

2436

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 8 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This first non-final action is in response to the Request for Continued Examination filing of 07/29/2008. Claims 1, 2, 4-6, 8, & 16-20 are pending and have been considered as follows.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:
 - Claims 1 & 16 lines 6-7, 11-12, 20-23, & 27-29 recite, “in response to receiving a unique identification number from the mobile device” and “first data storage mechanism is not directly accessible by the mobile device” and “content of the list of service providers is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device,” however, these limitations appear to lack antecedent basis in view of the applicant's Specification.

Claim Objections

2. Claims 1 & 11 are objected to because of the following informalities:
 - Claim 1 line 1 recites the term “for” which should be “...of...” since the usage of the term “for” renders the limitations which follow it as appearing to be intended use;

- Claim 11 lines 1, 4, 8, 10, 12, & 14 recite the term “for” which should be “...configured to...” since the usage of the term “for” renders the limitations which follow it as appearing to be intended use;

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) *statements of intended use or field of use,*
- (B) *“adapted to” or “adapted for” clauses,*
- (C) *“wherein” clauses, or*
- (D) *“whereby” clauses.*

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 & 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Claim 1
 - o Lines 7, 12, & 27-29 recite, “in response to receiving a unique identification number from the mobile device” and “first data storage mechanism is not directly accessible by the mobile device” and “content of the list of service providers is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device,” however, these limitations appear to lack support in view of the applicant's Specification and are therefore considered as new matter;
- Claim 16:
 - o Lines 6, 11, & 20-23 recite, “in response to receiving a unique identification number from the mobile device” and “first data storage mechanism is not directly accessible by the mobile device” and “content of the list of service providers is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device,” however, these limitations appear to lack support in view of the applicant's Specification and are therefore considered as new matter;
 - o Lines 3, 5, 7, 12, & 15 recite “a logic unit” however, these limitations appear to lack support in view of the applicant's Specification and are therefore considered as new matter;

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 16 lines 3, 5, 7, 12, & 15 recite "a logic unit" however, it is unclear as to whether all of the "logic units" are the same or several individually distinct units.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claim 16 recites "a secured communication system for a mobile communications network" comprising logic units, however, the "logic units" appear to be nothing more than computer software/program modules, thereby invoking 35 U.S.C. 101 as non-statutory subject matter.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4, 16, 17, & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind et al. (US-6980660-B1).

Claims 1 & 16:

Hind et al. disclose a secured communication method & system for a mobile communications network comprising,

- “receiving a request to provide a security key to a mobile device connected to the mobile communications network” (i.e. “The server executes an inquiry to the enterprise device when it is within acceptable proximity. The enterprise device returns its unique device identifier, preferably a 48 bit IEEE (MAC) address”) [column 8 lines 59-62];

- “generating a unique security key for the requesting mobile device in response to receiving a unique identification number from the mobile device” (i.e. “Under secure conditions the server then creates a public/private key pair and associated certificate for the enterprise device and securely transmits these data items to the device for which they were created”) [column 8 lines 63-66];
- “storing the unique security key in a first data storage mechanism in association with the unique identification number identifying the mobile device” (i.e. “In the preferred embodiment, a copy of the device certificate is also stored in an enterprise access control database for future reference”) [column 9 lines 55-57];
- “wherein the first data storage mechanism is accessible to a server system connected to the mobile device over a wide area communication network” (i.e. “In the preferred embodiment, a copy of the device certificate is also stored in an enterprise access control database for future reference”) [column 9 lines 55-57];
- “wherein the first data storage mechanism is not directly accessible by the mobile device” (i.e. “In the preferred embodiment, a copy of the device certificate is also stored in an enterprise access control database for future reference”) [column 9 lines 55-57];
- “receiving a request to provide the unique security key for the mobile device to a service provider such that the service provider can provide a service to the mobile device based on the unique security key” (i.e. “the first device 2003 sends a connection request 2005 to the second device 2001”) [column 11 lines 14-15];

- “approving the request to provide the unique security key to the service provider based on content of (a list of service providers) stored in a second data storage mechanism” (i.e. “As authentication proceeds, the special memory (protected storage) is asked to sign with the local device's private key (protected value) to prove said device's identity to the second device, and the special memory is asked to verify the CA's signature to validate the second device's certificate, so that the public key contained in said certificate can be trusted to verify the second device's signature”) [column 11 lines 32-37];
- “wherein the second data storage mechanism is directly accessible by the mobile device” (i.e. “the special memory (protected storage)”) [column 11 lines 32-33];
- “wherein the content of (the list of service providers) is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device” (i.e. “have the device certificate expire and require the user of the device to periodically renew the device certificate”) [column 12 lines 14-16];

but, they do not explicitly disclose,

- “list of service providers,” although Hind et al. do suggest a certificate with optional fields which act similarly to a list that determines which groups/users have access/authentication rights, as recited below;

however, Hind et al. do disclose,

- “the receiving resource 5001 examines the optional data in the decrypted certificate 5100. Upon examining the data, the first resource 5001 makes a decision as to whether to allow access based on the fields of the certificate and locally stored information 5110” [column 12 lines 33-37];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "list of service providers," in the invention as disclosed by Hind et al. for the purposes of providing a more granular level of access control (i.e. user, group, etc.) between devices.

Claims 2 & 17:

Hind et al. disclose a secured communication method & system for a mobile communications network, as in Claims 1 & 16 above, further comprising,

- "denying the request to provide the unique security key, if the service provider is not approved to receive the unique security key for the mobile device according to the content of the list of service providers stored in the second data storage mechanism" (i.e. "the receiving resource 5001 examines the optional data in the decrypted certificate 5100. Upon examining the data, the first resource 5001 makes a decision as to whether to allow access based on the fields of the certificate and locally stored information 5110") [column 12 lines 33-37].

Claims 4 & 18:

Hind et al. disclose a secured communication method & system for a mobile communications network, as in Claims 1 & 16 above, further comprising,

- "the second data storage mechanism is a memory chip embedded in the mobile device" (i.e. "smartcard chip") [column 8 line 36].

10. Claims 5, 6, 8, 19, & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind et al. (US-6980660-B1) in view of Ketcham (US-6075860-A).

Claims 5 & 19:

Hind et al. disclose a secured communication method & system for a mobile communications network, as in Claims 1 & 16 above, but they do not explicitly disclose,

- “the second data storage mechanism is an identity module removably insertable in the mobile device,” although Ketcham does suggest an authentication that is insertable and removable, as recited below;

however, Ketcham does disclose,

- “Authentication card 118 stores an MSID 204, an authentication encryption key 206, and optionally may store other information such as algorithmic identifiers 402, optional parameters 412 for configuring or personalizing a remote terminal 102 according to an authorized user's preferences” [column 8 lines 13-18];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, “the second data storage mechanism is an identity module removably insertable in the mobile device,” in the invention as disclosed by Hind et al. for the purposes of providing a removable/insertable authentication card similar to a “smart card” as recited by Hind et al. [column 8 line 36].

Claims 6 & 20:

Hind et al. disclose a secured communication method & system for a mobile communications network, as in Claims 1 & 16 above, but they do not explicitly disclose,

- “the second data storage mechanism is a SIM card for the mobile device,” although Ketcham does suggest a GSM SIM, as recited below;

however, Ketcham does disclose,

- “authentication card 118 takes the form of a GSM subscriber identity module (SIM)”
[column 8 lines 21-23];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant’s invention to include, “the second data storage mechanism is a SIM card for the mobile device,” in the invention as disclosed by Hind et al. for the purposes of having an embedded identifier used in authentication as would be reasonably expected from a mobile device.

Claim 8:

Hind et al. disclose a secured communication method for a mobile communications network, as in Claim 1 above, but they do not explicitly disclose,

- “the unique identification number is at least one of the mobile device’s electronic serial number (ESN), international mobile equipment identity (IMEI) and phone number,” although Ketcham does suggest utilizing a stored mobile subscriber identity or some other form of unique identity, as recited below;

however, Ketcham does disclose,

- “Authentication card 118 stores an MSID 204, an authentication encryption key 206, and optionally may store other information such as algorithmic identifiers 402, optional parameters 412 for configuring or personalizing a remote terminal 102 according to an authorized user's preferences” [column 8 lines 13-18];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, “the unique identification number is at least one of the mobile device's electronic serial number (ESN), international mobile equipment identity (IMEI) and phone number,” in the invention as disclosed by Hind et al. for the purposes of providing a unique identifier used in authentication.

Response to Arguments

11. Applicant's arguments with respect to Claims 1, 2, 4-6, 8, & 16-20 have been considered but are moot in view of the new ground(s) of rejection as necessitated by the applicant's amendments.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Oscar Louie whose telephone number is 571-270-1684. The examiner can normally be reached Monday through Thursday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami, can be reached at 571-272-4195. The fax phone number for Formal or Official faxes to Technology Center 2100 is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAL/
10/10/2008

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436